

– Remarks –

Claims 1-23 are in the case, the same number as originally filed. Claim 8, which originally was a dependent claim, is now an independent claim, making a total of three (3) independent claims. Accordingly, it is believed that no additional “excess claims” fee is due. However, if one is due, please charge it to the Deposit Account of the undersigned #16-2605/PMorgK03-Tank. An extra copy of this page is attached..

The Examiner has rejected all of the original claims, except Claim 8, which was indicated as being allowable if the limitations of the claims upon which it was dependent (Claims 1 & 7) were added to Claim 8. Claim 8 has now been so re-written adding most if not all of the substantive limitations of Claims 1 & 7 upon which Claim 8 had been dependent.

In adding in those substantive limitations the “112” language form issues raised by the Examiner were kept in mind and it is believed that the “112” issues have been avoided in the re-writing of Claim 8 except as noted below. Accordingly, Claim 8 should now be fully allowed.

In rejecting all of the other claims, the Examiner relied primarily on the patent to Bromwell (5,794,818) with the rejection being under either “102” or “103.” The Examiner also cited the patents to Ata (4,746,034) and (Harrison) Leland (1,563,199) as secondary references under “103” asserted “obviousness.”² The Examiner is

² The Examiner also cited but did not apply to any of the claims the Patents to Koch, Rudbach, McKibben and Thomas. These patents have been reviewed
(continued...)

respectfully requested to reconsider the allowability of the rejected claims in view of the claims as originally presented and as currently amended, as well as the “remarks” and legal precedents cited below.

The Bromwell patent is directed to a type of container for bulk materials (including liquids) which is a **totally different in type and kind** of container than that of the present invention. The Bromwell approach includes an outer plastic shell-type of container 11-12 made up of an upper shell 11 and a lower shell 12 which can be assembled and thereafter taken apart designed to contain and protect a flexible, plastic bottle 13, in which any liquid material is placed. The outer, protective container 11-12 is never afixedly attached to the material containing bottle 13 and the two are easily separable and removeable from one another by design. The walls of the separate, liquid containing bottle 13 is of unified, single wall structure. In order to better protect the flexible, plastic bottle 13, the plastic container shells 11-12 include ribs which interface at their edges with the outer surface of the single wall of the plastic bottle and there is not a parallel relationship between the various walls and that of the liquid containing bottle. Indeed the flexibility of the plastic material is designed to move through the spaces between the ribs.

In great contrast the tank of the present invention is made of metal, preferably stainless steel, in which there is a rigid, dual wall structure made up of two sets of flat

²(...continued)
but, like the cited and applied patents, none of them fairly teach or suggest the present invention either individually or in any appropriate combination under “103”.

facing walls which are affixed and are parallel to one another with a relatively small spacing or gap between them. Note, for example, the following quoted language from Claim 1:

“inner fluid containing tank member made up of **metal** (line 8) ...two, interior end members, comparable to said interior side wall members but **of a lesser width** (lines 13 & 14)...collectively together forming a first, interior, **metal** tank “skin” **designed to hold liquid** (lines 15 & 16)...a comparable but slightly larger, outer, enclosing, protective member, likewise made up of **metal** (lines 17 & 18)...collectively together forming a second, exterior “skin,” substantially completely enclosing the interior, tank “skin” producing a double wall tank structure **fixedly permanently connected together** (lines 24-26)...with the respective members of the two, tank “skins” being **parallel** generally separated by **small gaps**, except at their respective bottom members, which are in face-to-face engagement, being flat one on top of the other with no spacing between them” (lines 27-30).

Comparable language is also found in independent Claim 16.³

Additionally, the intended sizes of Bromwell’s relatively complex structure and that of the present invention are totally different by design, with the present invention height being less or no more than one of its other, lateral dimensions.

³ The other independent claim, Claim 8, has already been indicated as being allowable and was not rejected under “102.”

Additionally, of course, there are many other key and important distinctions between the approaches of Bromwell and that of the present inventio, as brought out in the other dependent claims.

It is believed clear that the claims are all “novel” under “102,” noting for example, the claim language of the two rejected independent claims, namely, Claims 1 & 16 as brought out above. Accordingly, the real remaining issues is the question of asserted “obviousness,” which will now be considered in some detail.

The very recent decision of the CAFC , issued less than a month ago,⁴ offers detailed guidance on the issue of asserted “obviousness” [*In re Kahn* (Fed. Cir. 2006, 04–1616, <http://fedcir.gov/opinions/04-1616.pdf> ; March22, 2006)], along with an analysis of relevant US Supreme Court and Board cases. As stated in CAFC “Kahn” decision:

“ In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in Graham v. John Deere Co. The Board determines “‘the scope and content of the prior art,’ “ascertains ‘the differences between the prior art and the claims at issue,’ ” and resolves “‘the level of ordinary skill in the pertinent art.’ ” Dann v. Johnston, 425 U.S. 219, 226 (1976) (quoting Graham, 383 U.S. at 17). Against this

⁴ This is in startling contrast to the quite old, single case cited in the Office Action, namely, *In re Rose* issued in 1955, over a half-century ago by a no-longer-existent court. The holding of the “patent” specialty CAFC takes precedence over any CCPA decisions if they are opposite in their holdings. Of course, the rather simplistic statement “A change in size is generally recognized as being within the level of ordinary skill in the art” without considering the facts of the case, which counsel is sure are quite different from those here, can itself lead to error, as here.

background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention. Graham, 383 U.S. at 17. In making this determination, the Board can assess evidence related to secondary indicia of non-obviousness like “commercial success, long felt but unresolved needs, failure of others, *etc.*” *Id.*, 383 at 17-18; accord Rouffett, 149 F.3d at 1355. We have explained that

[t]o reject claims in an application under section 103, **an examiner must show an unrebutted *prima facie* case of obviousness**⁵....On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness..

Rouffett, 149 F.3d at 1355.

Most inventions arise from a combination of old elements and each element may often be found in the prior art. *Id.* at 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357. Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the Board “**explain the reasons one**

⁵ All emboldened text has been added by the undersigned to highlight the most relevant text of the “Kahn” decision.

of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”

Id. at 1357-59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the Graham test.

When the Board⁶ does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. *Id.* at 1358. The “motivation-suggestion-teaching” requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. See 35 U.S.C. § 103 (stating that obviousness must be assessed “at the time the invention was made”); Dembiczak, 175 F.3d at 998 (“[I]t is this phrase that guards against entry into the tempting but forbidden zone of hindsight.” (internal quotations omitted)); Giles S. Rich, Laying the Ghost of the Invention Requirement, 1 APLA Q.J. 26-45 (1972), reprinted in 14 Fed. Cir. B.J. 163, 170 (2004) (“To protect the inventor from hindsight reasoning, the time is specified to be the time when the invention was made.”) (emphasis in original). The Supreme Court recognized the hindsight problem in Graham and proposed that “legal inferences” resulting from “secondary

⁶ At this level of the proceedings, the Examiner, but such, it is respectfully submitted, has not been done here.

considerations” might help to overcome it. 383 U.S. at 36 (“[Secondary considerations] may also serve to **guard against slipping into use of hindsight, and to resist the temptation to read into the prior art the teachings of the invention in issue.**” (internal quotations omitted)). By requiring the Board to explain the motivation, suggestion, or teaching as part of its *prima facie* case, the law guards against hindsight in all cases — whether or not the applicant offers evidence on secondary considerations—which advances Congress’s goal of creating a more practical, uniform, and definite test for patentability. See Dann, 424 U.S. at 225-26 (“[I]t was only in 1952 that Congress, in the interest of ‘uniformity and definiteness,’ articulated the requirement in a statute.” (quoting S. Rep. No. 1979, at 6 (1952); H.R. Rep. No. 1923, at 7 (1952))); Graham, 383 U.S. at 17 (“The § 103 [test], when followed realistically, will permit a more practical test of patentability.”).

Although our predecessor court was the first to articulate the motivation-suggestion-teaching test, a related test — the “analogous art” test — has long been part of the primary Graham analysis articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35. **The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.** In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are

selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ — in other words, common sense — in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See *id.*; *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992).

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); Graham, 383 U.S. at 35; Dann, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as

the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.

In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (internal citations omitted).

However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which **ensures due process and non-arbitrary decision making**, as it is in § 103. See *id.* at 1344-45.

In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. See, *e.g.*, Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1323 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); Ecolchem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1372 (Fed.

Cir. 2000) (“Although the suggestion to combine references may flow from the nature of the problem, ‘[d]efining the problem in terms of its solution reveals **improper hindsight in the selection of the prior art relevant to obviousness.**’” (internal citation omitted) (quoting Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998))); In re Beattie, 974 F.2d 1309, 1312 (Fed. Cir. 1992) (“[T]he law does not require that the references be combined for the reasons contemplated by the inventor.”); Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (characterizing the relevant inquiry as “[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention,[] have selected the various elements from the prior art and combined them in the manner claimed”); see also Graham, 383 U.S. at 35 (characterizing the problem as involving mechanical closures rather than in terms more specific to the patent in the context of determining the pertinent prior art). Therefore, the “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See Cross Med. Prods., 424 F.3d at 1321-24. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and

the level of skill in the art — *i.e.*, the understandings and knowledge of persons having ordinary skill in the art at the time of the invention — support the legal conclusion of obviousness. See Princeton Biochemicals, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).”

In contrast to the requirements above laid out recently by the controlling CAFC for asserting “obviousness,” the Office Action in the current application merely states an over-simplified “A change in size is generally recognized as being withing the level of ordinary skill in the art” and fails to provide any “analogous art test” or any “‘motivation-suggestion-teaching’ test” but merely uses, it is respectfully believed, prohibited “hind-sight.” Such, a “103” rejection, it is respectfully submitted, is fatally defective.

Applicants here have made a very worthwhile⁷ “contribution to the useful arts” deserving of patent protection.

Thus, upon consideration, all of the claims in the case, namely, Claims 1-23 should be allowed in this application.

It is noted that a Request for a one (1) month of extension of time is being concurrently submitted, along with a check for the \$65.00 (“small entity”) fee.

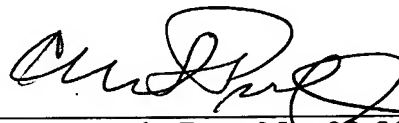
⁷ Indeed, the present invention has met with significant commercial success in solving this long felt need in the types of liquid transport tanks of the present invention.

If any additional fee is required, please charge it to the Deposit Account of the undersigned #16-2605/PMorgK03-Tank. An extra copy of this page is attached.

The Examiner's thorough, detailed, diligent review of the specification and claims is acknowledged and very much appreciated.

It is believed that the application is now in condition for full allowance, and such action is respectfully requested.

Respectfully submitted:



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- Certificate of Mailing -

I hereby certify that this Response (Amendment A), along with an Extension of Time request, and related checks are being deposited with the United States Postal Service, with proper, 1st class postage, in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on this **April 10, 2006**.



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4/10/2006

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